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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RHODE JR, ROBERT E

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/607,913

Applicant(s)

CUE ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 7 and 29 – 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For example in Claim 1, the applicant has not recited the use of any technology.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 5, 6, 8, 9, 12, 13, 15, 16, 18, 19, 22, 23, 24, 25 and 26 rejected under 35 U.S.C. 102(b) as being unpatentable over “All to play in the US toy market: In less than two years eToys has gained a lead that would-be competitors will find hard to make up”; Financial Times; London; May 25, 1999; Tim Jackson (hereafter referred to as eToys)

Regarding Claim 1 and related Claims 8, 15 and 22, eToys teaches a method, computer readable medium, server system and apparatus comprising – receiving order selections from a first user (Page 2, Para. 5); saving stored order data, the stored order data including the order selections (Page 2, Para 5 and 15); and in response to a first user request, automatically producing and sending an electronic mail message concerning the stored order to a recipient, the electronic mail message identifying the stored order and allowing the recipient to purchase the stored order (Page 2, Para 5 and 15).

Regarding Claim 2 and related Claims 9, 16 and 23, eToys teaches a method, computer readable medium, server system and apparatus further comprising producing a display of the stored order for potential purchase by the recipient (Page 2, Para 5 and 15).

Regarding Claim 5 and related Claims 12, 18 and 25, eToys teaches a method, computer readable medium, server system and apparatus wherein the stored order includes a single item (Page 2, Para 15).

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Regarding Claim 6 and related Claims 13, 19 and 26, eToys teaches a method, computer readable medium, server system and apparatus wherein the stored order includes a main item and at least one accessory (Page 2, Para 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 7, 10, 11, 14, 17, 20, 21, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over “All to play in the US toy market: In less than two years eToys has gained a lead that would-be competitors will find hard to make up”, in view of Fortenberry et al (US Patent 6,101,485).

eToys discloses and teaches a method, computer readable medium, server system and apparatus that receives order selections from a first user and saving the stored order data, which includes the order selections – as well as in response to a first user request, automatically producing and sending an electronic mail message concerning the stored order to a recipient, the electronic mail message identifying the stored order and allowing the recipient to purchase the stored order.

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eToys does not disclose and teach specifically regarding a method, computer readable medium, server system and apparatus, which includes a web page display of the recipient's stored purchase order or an email incorporating a URL – as well as the capability of receiving the order selections, includes the display of possible selections for the user.

However regarding Claim 3 and related Claims 10, 17 and 24, Fortenberry teaches a method, computer readable medium, server system and apparatus wherein the display-producing step comprises producing a web page display of the stored order for purchase by the recipient (Abstract).

Regarding Claim 4 and related Claims 11, 20 and 28, Fortenberry teaches a method, computer readable medium, server system and apparatus wherein the electronic mail message includes a URL which allows for the construction of a web page displaying the stored order (Col 2, lines 22 – 55).

Regarding Claim 7 and related Claims 14, 21 and 27, Fortenberry teaches a method, computer readable medium, server system and apparatus wherein the step of receiving the order selections includes providing an electronic display of possible selections for the user (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the methods, computer medium, server system and apparatus of eToys with the methods, computer medium, server system and apparatus of Fortenberry to have provided the capabilities from an email to display a web page of an order by activating a URL contained in the message – in order to enable a recipient to purchase the product immediately and thereby increase the probability of sale for the electronic commerce site as well as for the product supplier.

Claims 29 - 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over eToys in view of Fortenberry (US Patent 6,101,485) and further in view of “Will Gift Lists Click?” New York Times; New York; Nov 18, 1999 and associated Waybackmachine screen captures of the Della.com web site content of March 4, 2000 (hereafter referred to as Della).

The combination of eToys and Fortenberry does disclose and teach a method, computer readable medium, server system and apparatus that receives order selections from a first user and saving the stored order data which includes the order selections – as well as in response to a first user request, automatically producing and sending an electronic mail message which includes a URL concerning the stored order to a recipient, the electronic mail message identifying the stored order and allowing the recipient to display and purchase the stored order.

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The combination of eToys and Fortenberry does not specifically disclose and teach a method, computer readable medium, server system and apparatus with the capability of receiving first order selections from a first user, the order selections including at least one main item and at least one accessory for the main item; saving first stored order data, the first stored order data including the first order selections; receiving second order selections from the first user; saving second stored order data, the second stored order data including the second order selections; and thereafter, in response to a request from the first user, providing a display of the unpurchased first and second stored orders the display allowing the user to select the first or the second order for review.

However, regarding Claim 29 and related Claims 33, 37 and 41, Della teaches a method, computer readable medium, server system and apparatus comprising - receiving first order selections from a first user, the order selections including at least one main item and at least one accessory for the main item; saving first stored order data, the first stored order data including the first order selections (Page 5); receiving second order selections from the first user (Page 5); saving second stored order data, the second stored order data including the second order selections (Page 5); and thereafter, in response to a request from the first user, providing a display of the unpurchased first and second stored orders the display allowing the user to select the first or the second order for review (Page 5).

Regarding Claim 30 and related Claims 34, 38 and 42, Della teaches a method, computer readable medium, server system and apparatus wherein the first and second order selections are selected from a web page from an electronic commerce site (Page 2, Para 5 and Page 5).

Regarding Claim 31 and related claims 39 and 43, Della teaches a method, computer readable medium, server system and apparatus wherein the display of the first or second order is a web page display (Page 5).

Regarding Claim 32 and related Claims 36, 40 and 44, Della teaches a method, computer readable medium, server system and apparatus wherein the display of the first or second orders includes a link to a display of the items of the first order and a display of the items of the second order (Page 5).

Regarding Claim 35, Della teaches a method, computer readable medium, server system and apparatus, wherein the display of the first and second orders comprises a web page (Page 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of eToys and Fortenberry with the methods, computer medium, server system and apparatus of Della to have provided the capabilities of receiving a first order selections from a first user, the order selections including at least

one main item and at least one accessory for the main item and saving first stored order data receiving second order selections from the first user; saving second stored order data, the second stored order data including the second order selections and thereafter, in response to a request from the first user, providing a display of the unpurchased first and second stored orders the display allowing the user to select the first or the second order for review – in order to provide the user with capability to review the current lists of desired products as potential gifts, add or delete as necessary and also serves as a reason for the user to return to the electronic commerce site more often as well as increasing the probability of another purchase.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art includes Messer (US Patent 5,991,740) and Dodd (US Patent 6,321,211 B1) which specifically address the ability from an email with a URL to enable a link to an electronic commerce site and “E-list help in making gift wishes come true”; Times Union; Albany; Dec. 15, 1999; Frances Katz which address the proliferation of sites with the capability for site visitors to use wish list for storing and sending to select individuals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

RER

December 23, 2002